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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/726,646 | 12/04/2003 | John A. Picone | 1223.004 | 6180 |
| 7590 | 02/22/2005 | | | EXAMINER |
| Liniak, Berenato, Longacre & White Ste. 240 6550 Rock Spring Drive Bethesda, MD 20817 | | | SMITH, JAMES G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3723 | |

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/726,646 | PICONE, JOHN A. |
| | Examiner | Art Unit |
| | James G. Smith | 3723 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-8 and 11-29 is/are rejected.
- 7) Claim(s) 9 and 10 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/4/03 & 6/3/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 24, on page 23 has been renumbered 29. ***Claim Rejections***

- 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Both claims are to a powered adjustable wrench, however they depend from claim 1 which is not powered, thus they are indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 7, 8, 11, 12, 14, 25 and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Green which shows stops in the form of ball detents for both inward and outward movement of the sliding jaw.
6. Claims 1-6, 14, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Garrison which shows a portion of the worm gear abutting a shoulder on the sliding jaw to function as a stop.
7. Claims 1, 7, 8, 11, 12, 14, 25 and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Elmore which also shows a ball detent that functions as a stop.
8. Claims 1, 7, 8, 11, 12, 14, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boyer which shows a detent that functions as a stop.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrison in view of Jovanovich.

Garrison shows the claimed invention except for the use of a stop in both the inward and outward directions. Jovanovich suggests that a wrench with gear operated movable jaws can have a portion of the toothed sliding jaw free of teeth to function as stops in two opposite directions. It would therefore be obvious to one

skilled in the art at the time the invention was made to modify Garrison by using a stop area in two directions instead of one because Jovanovich suggests the use of such a dual direction stop to limit both inward and outward movement of the sliding jaw.

11. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of Demurger.

Any of Green, Garrison, Boyer or Elmore shows the claimed invention except for the use of plastic to make all or a portion of a wrench. Demurger suggests that a wrench can be made of a plastic material for weight reduction or manufacturing cost reduction. It would therefore be obvious to one skilled in the art at the time the invention was made to modify any of Green, Garrison, Boyer or Elmore by using plastic to make the tool because Demurger suggests the use of such a material of construction in wrenches to make them lighter or more easily manufactured.

12. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of Ratigan.

Any of Green, Garrison, Boyer or Elmore shows the claimed invention except for the use of a cored area to reduce weight. Ratigan suggests that a wrench can be made with a cored area for weight reduction. It would therefore be obvious to one skilled in the art at the time the invention was made to modify any of Green, Garrison, Boyer or Elmore by using cored areas because Ratigan suggests the use of such a construction in wrenches to make them lighter.

13. Claims 17, 18, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of either Lin or Quigley.

Any of Green, Garrison, Boyer or Elmore shows the claimed invention except for the use of jaw inserts attachable to one or both jaws. Either Lin or Quigley suggests that a can have inserts attached to each jaw for the purpose of adding grip enhancing material to the jaws. It would therefore be obvious to one skilled in the art at the time the invention was made to modify any of Green, Garrison, Boyer or Elmore by using jaw inserts because either Lin or Quigley suggests the use of such inserts to enhance the grip of the jaws.

To make any of the inserts magnetic to hold onto the workpiece is well known in the tool art and is therefore obvious to one skilled in the art.

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of Quigley, for the reason stated in paragraph 13, above.

15. Claims 17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of Machmeier, for the same reason as stated in paragraph 13, above.

16. Claims 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Green, Garrison, Boyer or Elmore in view of Picone.

Any of Green, Garrison, Boyer or Elmore shows the claimed invention except for the use of a power drive source to move the worm gear. Picone suggests that a

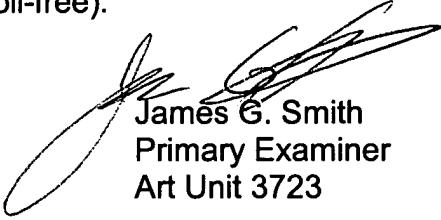
screw drive wrench can be powered with a cover. It would therefore be obvious to one skilled in the art at the time the invention was made to modify any of Green, Garrison, Boyer or Elmore by using a power source to drive the gear because Picone suggests the use of such a power source for the same purpose as that claimed.

Allowable Subject Matter

17. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
18. The remaining prior art is cited only as of interest at this time.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G. Smith whose telephone number is 571-272-4496. The examiner can normally be reached on M-Th (7:05- 4:35) Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James G. Smith
Primary Examiner
Art Unit 3723

jgs
2/17/05